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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,208	12/07/2001	Gary Heartsfield	077662.000008	1383

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EXAMINER

THOMAS, ALEXANDER S

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/021,208

Applicant(s)

HEARTSFIELD, GARY

Examiner

Alexander Thomas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 23-59 is/are pending in the application.
- 4a) Of the above claim(s) 52-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/2/04, 8/18/03, 10.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/2/04 has been entered.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 23-51, drawn to an article, classified in class 428, subclass 53.
  - II. Claims 52-59, drawn to a process, classified in class 156, subclass 252.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a different process such as by forming pieces of foam and then laminating them to a continuous layer.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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5. During a telephone conversation with Ms. Calico on February 4, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 23-51. Affirmation of this election must be made by applicant in replying to this Office action. Claims 52-59 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 23, 27, 40 and 44-51 are rejected under 35 U.S.C. 102(b) as being anticipated by the French patent document ('057). See page 2 of the translation. The term "flame lamination" and the subject matter of claims 45-51 are process limitations that do not add any structurally distinguishing features to the claimed article since the final article is structurally indistinct from the prior art articles.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 24, 26, 41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over the French patent document ('057). The reference discloses the invention substantially as claimed; see page 2 of the translation. However it does not disclose the use of vinyl or canvas as a top layer. The reference does disclose the use of textiles and synthetic materials as a top layer in its gymnastics mat; see page 2 of the translation. Vinyl and canvas are well known synthetic and textile materials, respectively. It would have been obvious to one of ordinary skill in the art to select any well known textile or synthetic material, such as canvas or vinyl materials, as the top layer in the article of the reference depending on the desired structural properties of the mat. The various process limitations, such as "water-jet-cut", do not add any structurally distinguishing features to the claimed article since the final article is structurally indistinct from the prior art articles.

10. Claims 25 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the French patent document ('057) in view of Kantor ('462). The primary reference discloses the invention substantially as claimed; see page 2 of the translation. However it does not disclose the use of carpet as a top layer. The secondary reference discloses the use of carpet as a top layer over a foam layer in an article used as a gymnastic mat; see the Abstract. It would have been obvious to one of ordinary skill in the art to use carpet as a top layer in the article of the primary reference in view of the teachings in the secondary reference to provide a surface that is safe for a variety of applications where people are likely to fall down. The various process limitations, such as "water-jet-

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cut", do not add any structurally distinguishing features to the claimed article since the final article is structurally indistinct from the prior art articles.

11. Claims 28, 29 and 31-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the French patent document ('057) in view of the German patent document ('307). The primary reference discloses the invention substantially as claimed; see page 2 of the translation. However it does not disclose the use of a closed cell foam as the foam material. The secondary reference discloses the use of closed-cell foam as a support layer in gymnastic mats; see page 1 of the translation. It would have been obvious to one of ordinary skill in the art to use a closed-cell foam, as suggested in the secondary reference, as the foam material in the article of the primary reference to provide the desired structural properties for a particular end use. The various process limitations, such as "flame lamination" and the subject matter of claims 36-39, do not add any structurally distinguishing features to the claimed article since the final article is structurally indistinct from the prior art articles.

12. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over the French patent document ('057) in view of the German patent document ('307) as applied to claims 28, 29 and 31-39 above, and further in view of Kantor. Kantor discloses the use of carpet as a top layer over a foam layer in an article used as a gymnastic mat; see the Abstract. It would have been obvious to one of ordinary skill in the art to use carpet as a top layer in the article of the primary reference in view of the

teachings in the secondary reference to provide a surface that is safe for a variety of applications where people are likely to fall down.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Thomas whose telephone number is 571-272-1502. The examiner can normally be reached on 6:30-4:00 M-THUR.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ALEXANDER S. THOMAS  
PRIMARY EXAMINER